

REMARKS

Claims 1-27 are now pending and stand rejected. Applicants are submitting a Request for Continued Consideration (RCE) with this Preliminary Amendment. By this Preliminary Amendment, Applicants have amended the claims and demonstrate reasons why the claims pending here are distinct from the asserted art. In particular, Applicants have amended claims 1, 2, 11 and 18. . In view of the above amendments and the reasoning show below to demonstrate why the 35 U.S.C. § 103 rejections are improper, Applicants respectfully request the Examiner to reconsider the outstanding rejections and to withdraw them.

35 U.S.C. § 103 Rejections

At the outset, the Examiner has withdrawn the 35 U.S.C. Section 102(e) rejections but continues to maintain the 35 U.S.C. § 103 rejections. Although Applicants' understand the Examiner position, they refute it for the following reasons.

Governing Criteria

At the outset, Applicants urge the following legal reasoning and case law as the bases for rejections under 35 U.S.C. Section 103. For obviousness rejections, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03

To resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also point to the motivation in the asserted references that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An Examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed

invention, would select the elements from the cited prior art references for combination in the manner claimed.

In paragraph 2 of the office action, claims 1-27 are rejected under 35 U.S.C. § 103 as unpatentable over Vong et al. (U.S. Patent No. 6,209,011, "Vong") in view of Chari et al. (U.S. Patent No. 6,553,416). The Examiner acknowledges that Vong fails to teach "deleting from memory any outstanding attention requests that has been cleared and no longer needs user's attention." The Examiner asserts that Chari teaches a method and system for managing alerts similar to that of Vong. According to the Examiner, Chari further teaches the deletion of notification in column 12, lines 10-28 Chari, at the location indicated by the Examiner describes the following:

But in embodiment the alert notification is not deleted immediately; the notification deletion preferably only occurs after the user clicks on the 'Delete Notification' button 438 on the right side of the Alert Manager Window 400. Before the user clicks on the "Delete Notification" button 438, the user can click on other alert types to be deleted. After the user finishes selecting all the alert notifications to be deleted, the user clicks on the "Delete Notification" button 438. All alert notifications to be deleted are deleted together. Thus, the user can delete more than one alert notifications for one or all servers with a single command. This is shown in block 906. When the user is finished selecting alert types, the user clicks on the "Delete Notification" button 438 as shown in block 908. In blocks 910-912, the Alert Manager Dialog Module 216 calls the Alert Manager Module 202 (FIG. 2), which finds the servers or servers selected by the user in the Alert Manager Server List. In blocks 914-916, the Alert Manager Module 202 deletes alert notifications for the alerts designated by the user in the Alert Manager Table 1000 (FIG. 10) and waits for the next user command.

If Chari discloses deletion of notifications, the user must select each one and click on a button that activates the deletion. The present system determines if outstanding requests have not been cleared, displays a list of them, and then facilitates simultaneous deletion of those requests. Applicants respectfully submit that a combination of the two references as suggested by the Examiner is improper and would not have obvious to one of ordinary skill in the art, as

Application No.: 09/801,983
Reply to final Office Action of: July 25, 2006

neither reference explicitly recites the motivation to combine the references as suggested by the Examiner. Nor do both references address the same problems as the inventors of the present application and nor can it be assumed that one skilled in the art would have access to both these references. Moreover, even if the references were combined, the combination would not result in the claimed invention.

Conclusion

Applicants respectfully requests the Examiner to consider the legal reasoning, amendments and arguments urged here and to allow this application.

Respectfully submitted,

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Dated: January 25, 2007

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